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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,584	04/08/2004	Stephen Hart	20040117.ORI	6640

23595 7590 01/11/2007
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EXAMINER	
EPPS FORD, JANET L	
ART UNIT	PAPER NUMBER
1633	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,584	HART ET AL.	
	Examiner	Art Unit	
	Janet L. Epps-Ford	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26,31-33 and 39-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-26,31-33 and 39-41* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1, 3-11, 17-26, 31-33, 39 and 41, drawn to a method for suppressing the expression of a selected gene comprising the use of a molecule comprising a nucleic acid binding portion and an expression repressor portion.

Group II. Claims 2-11, 17-26, 31-33, and 40-41 drawn to a method for modulating the expression of a selected gene comprising the use of a molecule comprising a nucleic acid binding portion and a modifying portion.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The identified inventions relate to multiple methods which involve distinct objectives, distinct method steps, distinct materials, and producing distinct outcomes. The multiple methods are therefore considered to encompass multiple categories of invention. The claims are therefore not considered to have unity of invention as per 37 CFR 1.475(b)-(c), which state the following:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
(1) A product and a process specially adapted for the manufacture of said product; or
(2) A product and process of use of said product; or
(3) A product, a process specially adapted for the manufacture of the said

product, and a use of the said product; or
(4) A process and an apparatus or means specifically designed for carrying out the said process; or
(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.
(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

With the election of either Groups I or II, a further restriction is required as follows:

3. Group III, claim 4, drawn to a method according to claim 1 or 2 wherein the repressor or modifier is all or a portion of a component of a DNA methylase.

4. Group IV, claim 4 drawn to a method according to claim 1 or 2 wherein the repressor or modifier is all or a portion of a component of a polypeptide which binds to or facilitates the recruitment of a DNA methylase complex.

5. Group V, claim 5, drawn to a method according to claim 1 or 2 wherein the repressor or modifier is all or a portion of a component of a histone acetyltransferase.

6. Group VI, claim 5, drawn to a method according to claim 1 or 2 wherein the repressor or modifier is all or a portion of a component of a polypeptide which binds to or facilitates the recruitment of a histone acetyltransferase complex.

Claims 1-2 are linking claims to groups III-VI.

Groups III-VI are patentably distinct from each other because the repressor or modifier group corresponding to each group is structurally and functionally distinct from each other, and each requires a separate search and consideration of the prior art.

7. Additionally, the groups I-VI do not appear to share a special technical feature that makes a contribution over the prior art since the teachings of Buluwella et al. (WO

200102019) appears to render obvious the claimed methods of suppression comprising the use of an effector comprising a complex featuring HDAC.

8. This application contains claims directed to the following patentably distinct species: The claims recite various species of the chromatin inactivation portion, and of the HDAC complex. The species are independent or distinct because each species comprises a distinct chemical structure requiring a separate search and consideration of the prior art. Additionally, claim 33 recites patentably distinct species of host cells that are well known in the are to comprise distinct genomes, express and distinct set of genes, and comprise distinct structures, therefore necessitating a separate search and consideration of the prior art. Moreover, the various species lack unity of invention for the reasons set forth above.

Applicant is required under PCT Rule 13.1 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-11, 17-25, 31-32, 39-41 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

11. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

12. Claims 12-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. In the instant case, claim 12 (and those claims dependent therefrom) is dependent from claims 3 and 11, however both claims 3 and 11 depend from claims 1 or 2. See MPEP § 608.01(n). Once Applicants have properly amended these claims, applicants are requested to indicate which invention group the amended claims will read on.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Epps-Ford, Ph.D.
Primary Examiner
Art Unit 1633

JLE